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| | |
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| Re Applic of | Joel P. DeSouza |
| Docket No. | FIS920030091US1 |
| Serial No. | 10/604,146 |
| Filing Date | 6/27/03 |
| Attorney | H. Daniel Schnurmann |

Attached: Response to Office Communication

PLEASE DELIVER TO:

EXAMINER: Jack S. J. Chen

ART UNIT: 2813

PHONE NO:

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INTERNATIONAL BUSINESS MACHINES CORPORATION

Intellectual Property Law
East Fishkill Facility
2070 Route 52
Hopewell Junction
New York 12533-6531

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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING SENT VIA Facsimile Transmission to:
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Signature & Date

| IN THE UNITED STATES PATENT AND TRADEMARK OFFICE | |
|--|---|
| In re application of: Joel P. De Souza et al. | Date: January 18, 2005 |
| Serial Number: 10/604,146 | Examiner: Jack S J Chen |
| Filed: 6/27/03 | Group Art Unit: 2813 |
| Title: A Method of forming Silicon-on-Insulator Wafers having Process Resistant Applications | IBM Corporation D/18G, B/300, Zip 482 2070 Route 52 Hopewell Junction, NY 12533-6531 |

RESPONSE TO OFFICE COMMUNICATION

Commissioner of Patents and Trademarks
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated December 28, 2004.

The Examiner states in the Office Action that Applicants' reply to the Restriction Requirement was not fully responsive because Applicants elected Species I (Figure 3) but did not identify which claims read on the elected species.

In a Telephone Interview conducted on January 10, 2005 with the Examiner, Applicants' representative stated the no specific claims was elected in the Response to the Restriction Requirement because Applicants believe that Claim 1 is generic and applies to all the species listed by the Examiner. To prove this assertion, Applicants'

representative recited word by word Claim 1 to the Examiner and matched this recitation to the three Figs. 3, 4 and 5.

In response, the Examiner stated that he wanted to study Applicants' assertion to determine its validity.

Notwithstanding the aforementioned arguments, and in order to advance the prosecution of the present application, Applicants elect to prosecute claims 1 to 14 in conjunction with Species I (Figure 3).

It is understood that in the event where claim 1 is allowed as a generic claim, Applicants will be entitled to consideration to the additional species as recited in claims 15-20.

The election of claims is made without traverse.

Respectfully submitted,
JOEL P. DE SOUZA ET AL.

By:



H. Daniel Schurmann, Agent

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